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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,554	10/31/2003	Karl Johnson	081776-0306363	8401
909 7590 08/07/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER NGUYEN, PHONG H				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
08/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,554

Applicant(s)

JOHNSON ET AL.

Examiner

PHONG H. NGUYEN

Art Unit

3724

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 40-49, 51, 53 and 55-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 40-49, 51, 53 and 55-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/06/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22, 40-49, 51, 53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sederberg et al. (5,992,023), hereinafter Sederberg.

Sederberg teaches a metal demolition shears comprising a fixed jaw 14 having a fixed blade 66 with a first cutting/shearing edge, a movable jaw 16 having a second cutting/shearing edge (formed by blade 116) and a wear plate/piercing tip insert 140 having one cutting tip 144. See Figs. 1-14.

Sederberg fails to teach the geometric configuration of the wear plate/pierce tip insert 140 being the same in a first position and a second position, wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees.

Sederberg teaches the geometric configuration of the cutting tip of the blade 116 being the same in the first position and the second position. See Fig. 13 and 14.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide the wear plate/pierce tip insert 140 the geometric configuration as taught in the blade 116 (which is to have two cutting tips) so that both

ends of the wear plate/pierce tip insert 140 can be used to reduce the spare part of the wear plate/pierce tip insert.

It is to be noted that when a second cutting tip is provided to the wear plate/pierce tip insert, it would have been obvious to one skilled in the art not to expose the second cutting tip above the top of the moveable jaw 16 to interfere with the function of pulling roots of the moveable jaw. Fig. 2 teaches not exposing a wear plate 122 above the top of the moveable jaw 16 so that the wear plate 122 does not interfere with the function of pulling roots of the moveable jaw.

Response to Arguments

3. Applicant's arguments filed on 05/06/2008 have been fully considered but they are not persuasive.

The Applicant argues that there is no suggestion to modify the cutting tip of Sederberg, the modification relies on impermissible hindsight and Sederberg teaches away from the proposed modification. These arguments are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Figs. 13 and 14 teach the

use of a mirrored image part and design a symmetrical part is within the knowledge of one skilled in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the argument that Sederberg is a teach away reference, Fig. 2 teaches that the cutting tip can be provided below the rhino nose. Therefore, when the cutting tip is modified as taught in Figs. 13 and 14, the modified cutting tip is positioned below the rhino nose and does not destroy the function of the rhino nose.

The Applicant argues the commercial success of the invention. This argument is not persuasive. The evidence of the commercial success does mean that it is unobvious to modify the cutting tip. Furthermore, the commercial success could be due to a good marketing plan but not the structure of the cutting tip itself.

The Applicant argues that competitor's copying of the invention is an evidence of nonobviousness. The argument of alleged copying is not persuasive when the copy is not identical to the claimed product and the other manufacturers had not tried a substantial amount of time to develop its own product. Furthermore, the fact of copying may be due

to lacking of concern the copy right of the product due to misjudge the commercial success of the product.

It is to be noted that photocopies of the piercing tips provided in the affidavit have very low quality and thus, the Examiner cannot compare Genesis piercing tip to Stanley piercing tip.

The Applicant argues that since European Patent Office (EPO) granted a patent (EP 1,682,299) to a similar invention owned by the Applicant, it is an evidence of unobviousness. This argument is not persuasive. US Patent and Trademark Office (USPTO) and European Patent Office are two independent offices and each has its own set of rules to examine patent applications. What is obvious at USPTO may not be obvious at EPO and vice versa. Furthermore, the claims in EP 1,682,299 are not identical to the claims in the current patent application. Therefore, it is premature to assert the unobviousness of the current patent application based on EP 1,682,299.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHONG H. NGUYEN whose telephone number is (571)272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Timothy V Eley/
Primary Examiner, Art Unit 3724

/P. H. N./
Examiner, Art Unit 3724

August 3, 2008